

#### REMARKS

The Applicant respectfully submits this Amendment And Request For Reconsideration contemporaneously with the presently-filed Request for Continued Examination (RCE).

The last communication from the USPTO for the above-referenced patent application was the Notice of Panel Decision from Pre-Appeal Brief Review of 11 September 2008, which indicated that the case would proceed to the Board of Patent Appeals and Interferences.

In response, in order to reduce the issues and expedite allowance of the present application, the Applicant hereby submits this Amendment contemporaneously with the present RCE. In the present Amendment, the Applicant amends claims 1, 4, 11, 12, 15, and 22; no claims have been added or canceled. The Applicant respectfully requests entry of the amendment and reconsideration of the claims as revised based on the reasons presented herein.

*In the Final Office Action mailed on 27 March 2008, and as confirmed in the Advisory Action of 11 July 2008, the Examiner rejected claims 1-28 under 35 U.S.C. § 102(b) as being anticipated by Jin (U.S. Patent Application Publication No. US2002/0084888A1). In addition, the Examiner rejected dependent claims 9, 19, 21, and 28 under 35 U.S.C. § 103(a) as being obvious over Jin in view of Minborg (U.S. Patent No. 6,977,909). In response, the Applicant respectfully disagrees with the Examiner's rejections and submits that all pending claims 1-22 as revised are allowable over the prior art for at least the following reasons.*

In order for claims to be properly rejected under 35 U.S.C. § 102(b) and § 103(a), the prior art in combination must teach or suggest each and every limitation of the claims. In the present case, the relied upon art of the Examiner fails to teach or suggest each and every limitation of the claims.

The Applicant has revised the language of the independent claims, to confirm that the user-specific information items are indeed user-specific information items for use in *"identifying or contacting a user of the mobile station."* The relied upon art fails to teach or suggest the acts of "reading," "storing," and "repeating" which are performed "automatically" ... "in response to a trigger signal" for such user-specific information items as claimed in claims 1-22.

The Examiner must interpret the claims broadly – but only as broadly as is reasonable. To interpret the claims in a different way, other than as presented as understood by those ordinarily skilled in the art, would be unreasonable. If the Examiner's rejections are maintained, the Applicants submit that the Examiner would not be interpreting claims 1-22 in a reasonable fashion and/or is mischaracterizing the teachings of the relied upon art.

For discussion, the Applicant lists amended method claim 1 below. Method claim 1 recites:

1. A method for use in a mobile station for automatically grouping user-specific information items, each user-specific information item being for use in identifying or contacting a user of the mobile station, the method comprising the acts of:

in response to a trigger signal, automatically grouping the user-specific information items by a processor of the mobile station by:

reading, from a first file of the mobile station, a first user-specific information item for identifying or contacting the user;

storing the first user-specific information item in a user information file or a message of the mobile station; and

repeating the acts of reading, from a second file of the mobile station, and storing, in the user information file or the

message, for at least a second user-specific information item for identifying or contacting the user, so that the first and the second user-specific information items are grouped together as user information in the user information file or the message.

As apparent, the recited acts of "reading," "storing," and "repeating" are *indented* to the right of the "automatically grouping" recitation – all of which are performed "in response to a trigger signal." The claims are formatted and otherwise fashioned so that the acts of "reading," "storing," and "repeating" *structurally* fall under the purview of the single triggering act. Thus, proper interpretation thus requires that the acts of "reading" and "storing" of a first user-specific information item, as well as the acts of "reading" and "storing" again (i.e. the repeating act) of a second user-specific information item, are performed in response to the *single* trigger signal in the automatic grouping of user-specific information items which are for identifying or contacting the user.

In general, the Jin reference describes a system for sending and receiving personal information using a mobile terminal. A personal information is sent using a short message service with an attached identification information. This involves setting the mobile terminal to a personal information sending mode, and inputting personal information data by the user for transmission. As apparent, the Jin reference requires the user to manually enter the multiple user information items through an application. This is not what is claimed and generally illustrates the differences between the relied upon art and that which is claimed.

For the Examiner's alleged teaching of the claimed "in response to a trigger signal, automatically grouping" step, the Examiner recites to paragraph 31 of the Jin reference. In paragraph 31 of the Jin reference, it is taught that the user inputs the phone number of the receiving mobile terminal to which the user wants to transmit the personal information. It is further taught that the user can either input this phone

number manually or automatically. Thus, the Examiner alleges that the user inputting of the phone number of the receiving mobile terminal is the "trigger signal" which causes some "automatic grouping." However, this characterization is improper. If the user input of the phone number of the receiving mobile terminal in the Jin reference were to be treated as a "trigger signal", then there would only be a single set – not two sets - of "reading" and "storing" actions that would occur subsequently in response to the alleged trigger signal (i.e. the previous data has already been entered by the user, prior to the alleged trigger signal). There is no "repeating" action. In the present claims, the acts of "reading," "storing," and "repeating" (i.e. repeating the reading and storing for a second item) are performed in response to the same trigger signal.

Further, with respect to the Examiner's alleged demonstration of the claimed "[first] reading" step, the Examiner recites to FIGs. 4a-4f of the Jin reference. In FIGs. 4a-4f of the Jin reference, the manual inputting process for data by the user is illustrated. The manual user data entry of FIGs. 4a-4f, however, cannot be treated as the "[first] reading" step as the Examiner alleges. If the manual user data entry of FIGs. 4a-4f were to be treated as the "[first] reading" step, then the Examiner cannot reasonably argue that the user inputting of the phone number of the receiving mobile terminal (see paragraph 31 of the Jin reference) is the alleged trigger signal. The obvious reason is because the user inputting of the phone number *occurs after* the manual inputting process of the data by the user. A trigger signal which causes an alleged multi-step automatic grouping process cannot come *after* the automatic grouping process. Again, in the present claims, the acts of "reading," "storing," and "repeating" (i.e. repeating the reading and storing steps for a second item) are performed in response to the same trigger signal.

To further illustrate the deficiencies by dependent claims, the alleged teaching of the claimed "the trigger signal [being] produced in response to a user input request for the user information" (see e.g. claims 10 and 20), the Examiner makes reference to paragraph 42 of the Jin reference and states that "the command 'confirm' icon do the

act of reading, storing, and repeating.” Again, if the manual user data entry of the Jin reference were to be treated as the trigger signal, then the Examiner cannot also argue that the user inputting of the phone number of the receiving mobile terminal (see paragraph 31 of the Jin reference) is the alleged trigger signal. Again, in the present claims, the acts of “reading,” “storing,” and “repeating” are performed in response to the same trigger signal.

As apparent, it is difficult for the Examiner to provide even a single example in the Jin reference where the claimed actions are taught. The Applicant respectfully submits that the reason is because the relied upon art fails to teach or suggest the claimed limitations.

Using techniques of the prior art, if any user-specific information needed to be changed (e.g. when a new or updated e-mail address of the user is provided), the user would have to manually change the central file in addition to changing his/her email account information in the e-mail communication application. According to an embodiment of the present disclosure, however, the user would merely need to change his/her e-mail account information in the e-mail communication application – thereafter, the inventive technique would sometime automatically update the user information item(s) from the existing files/application(s) which includes the e-mail communication application.

Thus, according to the present techniques, methods and apparatus for use in *automatically* grouping user-specific information items are provided in a mobile station. A processor of the mobile station is adapted to automatically group user-specific information items in response to identifying a trigger signal. The automatic grouping of user-specific information items involves the following acts. A first user-specific information item for identifying or contacting the user is read from a first file of the mobile station, and the first user-specific information item is stored in a central user information file or a message of the mobile station. The acts of reading and storing are then *repeated* for at least a second user-specific information item for identifying or

contacting the user, so that the first and the second user-specific information items are grouped together as user information in the central user information file or the message of the mobile station.

As the relied upon art of the Examiner fails to teach or suggest an automatic grouping of user-specific information items, each of which is for identifying or contacting a user of the mobile station, in response to a trigger signal, the rejections should be withdrawn and the claims allowed.

Other reasons for allowability of both the independent and dependent claims are apparent to those skilled in the art, but are not detailed herein due to the already-indicated reasons for allowability.

Based on the reasons presented herein, the Applicants respectfully request the Examiner to withdraw the rejections of pending claims 1-22 as amended. The Applicants submit that the application as amended is in a condition suitable for allowance.

Respectfully submitted,

/John J. Oskorep/

Date: 10 November 2008

JOHN J. OSKOREP  
Reg. No. 41,234

JOHN J. OSKOREP, ESQ. LLC  
ONE MAGNIFICENT MILE CENTER  
980 N. MICHIGAN AVENUE, SUITE 1400  
CHICAGO, ILLINOIS 60611 USA  
Telephone: (312) 222-1860 Fax: (312) 475-1850